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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/053.238

10/29/2001

Kazuhiko Honda

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8692

7590

11/13/2006

Crowell & Moring LLP  
Intellectual Property Group  
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EXAMINER

PHAM, HAI CHI

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/053,238	HONDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hai C. Pham	2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on Response (09/01/06), Amendment (5/24/06).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-16, 20-22, 26-28 and 30-56 is/are pending in the application.
- 4a) Of the above claim(s) 21, 22, 26-28 and 38-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 and 20 is/are allowed.
- 6) ☒ Claim(s) 30-33 and 56 is/are rejected.
- 7) ☒ Claim(s) 34-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species I, including claims 14-16, 20, 30-37 and 56 in the reply filed on 09/01/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 21-22, 26-28 and 38-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotta et al. (US 6,489,265) in view of Lee et al. (US 6,576,318).

Hotta et al. discloses in Fig. 5 an optical storage medium comprising a substantially flat optical disc, the disc including at least one reflective layer (light reflecting layer 106b and reflective layer 104) and a visible light characteristic changing layer (reversible thermosensitive recording label layer 106 having crystalline-type

reversible thermosensitive recording layer 106c) provided over all of the at least one reflective layer, and a recording layer (103) provided on the at least one reflective layer.

Hotta et al. fails to teach at least one side surface of the visible light characteristic changing layer having a rough texture, the rough textured surface facing the reflective layer or facing away from the reflective layer, or the rough texture being on both surfaces of the visible light characteristic changing layer.

Regardless, it is well known in the art that the crystalline phase-change layer is formed by a high-temperature deposition method, and that the crystalline phase-change layer develops rough surface(s) during the process as evidenced by Lee et al. at col. 2, lines 3-10 and in Fig. 2.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the visible light characteristic changing layer in the device of Hotta et al. with rough surface(s) as taught by Lee et al. since Lee et al. teaches this to be known art that the surface of the visible light characteristic changing layer is having a rough texture by design.

With regard to claim 56, Hotta et al. further teaches the crystalline-type reversible thermosensitive recording layer (106c) being adjacent to the light reflecting layer (106b).

***Allowable Subject Matter***

6. Claims 14-16 and 20 are allowed.

7. Claims 34-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 30-33 and 56 have been considered but are moot in view of the new grounds of rejection.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2861

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HAI PHAM  
PRIMARY EXAMINER

November 9, 2006